



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,441	05/16/2002	Hung Y. Fan	UC11150-1	6562

7590 11/03/2004

LISA A. HAILE, PH.D.  
GRAY CARY WARE & FREIDENRICH LLP  
4365 EXECUTIVE DRIVE  
SUITE 1100  
SAN DIEGO, CA 92121

EXAMINER

CHEN, STACY BROWN

ART UNIT	PAPER NUMBER
----------	--------------

1648

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/030,441

Applicant(s)

FAN ET AL.

Examiner

Stacy B Chen

Art Unit

1648

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1,2,4-12 and 37-41.


Claim(s) withdrawn from consideration: 13-36 and 42-59.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: Applicant's amendment filed October 5, 2004 has not been entered because the rejection of claims 1 and 2 under 35 U.S.C. 112, first paragraph, is maintained for reasons of record. In the amendment of May 26, 2004, SEQ ID NO: 8 was added to the specification and to claims 1 and 2. SEQ ID NO: 8 was not part of the original disclosure, nor was its sequence spelled out in specification. Applicant points to page 23, lines 5-7, amended on May 26, 2004, which discloses that SEQ ID NO: 8 is a polynucleotide sequence of JSRV deposited as AF105220. It is unclear why Applicant is arguing that SEQ ID NO: 8 does not describe a polynucleotide sequence of the JSRV sequence having accession number AF105220 (see the response of October 5, 2005, page 12, first paragraph, third sentence from the end). Applicant also points to page 66, lines 2-3, which discloses that the nucleotide sequence of JSRV21 has been deposited in GenBank under accession number AF105220. Applicant argues that SEQ ID NO: 8 is the nucleotide sequence of JSRV21. Lacking an explanation of the seemingly contradictory statements regarding the identity of SEQ ID NO: 8 with respect to its deposit at GenBank and its relationship to JSRV21/AF105220, the claims remain rejected. If the amendment filed October 5, 2004 were to be entered, the rejections of claims 37-41 under 35 U.S.C. 112, first paragraph, for failing to meet the written description requirement, and under 35 U.S.C. 103(a) would be moot in view of the cancellation of claims 37-41. Further, the rejection of claims 4-12 under 35 U.S.C. 103(a) would be withdrawn because of the amendment of claim 4 to include the novel sequence of SEQ ID NO: 8.

SPC

10/22/2004

  
JAMES HOUSEL 11/1/04  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600